

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner now rejects claims 1-4 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,117,128 to Gregory (hereinafter "Gregory") in view of U.S. Patent No. 5,916,147 to Boury (hereinafter "Boury").

Additionally, the Examiner rejects claims 5-16 under 35 U.S.C. § 103(a) as being unpatentable over Gregory and Boury and further in view of U.S. Patent No. 5,084,022 to Claude (hereinafter "Claude").

In response, the Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below. However, independent claims 1 and 17 have been amended to clarify their distinguishing features.

Specifically, independent claim 1 has been amended to recite:

"a small-diameter portion which is included in the soft portion and whose outer diameter is substantially the same over the whole length thereof;

a large-diameter portion which is formed on the operator side of the soft portion opposite to the small-diameter portion and whose outer diameter is larger than the outer diameter of the small-diameter portion; and

a tapered portion linking the small-diameter portion and the large-diameter portion, wherein; at least part of the tapered portion is disposed forward an endoscope portion separated 70 cm from the distal endoscope end; and a thickness of a sheathing resin is varied in order to form the small-diameter portion, the large-diameter portion, and the tapered portion."

Similarly, independent claim 17 has been amended to recite:

"a soft portion including a small-diameter portion and a large-diameter portion;

the large diameter portion is formed on the operator side of the soft portion opposite to the small diameter portion and whose outer diameter is larger than an outer diameter of the small diameter portion; and

a tapered portion included in the soft portion linking the small-diameter portion and the large-diameter portion, wherein:
at least part of the tapered portion is separated 70 cm or less from a distal end, and a thickness of a sheathing resin is varied in order to form the small-diameter portion, the large-diameter portion and the tapered portion.”

The amendment to independent claims 1 and 17 are fully supported in the original disclosure, such as at page 6, lines 13-25 of the specification and at Figure 3 of the drawings. Thus, no new matter has been entered into the original disclosure by way of the present amendment to claims 1 and 17.

Therefore, independent claims 1 and 17 now expressly recite that the “thickness of the sheathing resin is varied in order to form the small-diameter portion, large-diameter portion, and tapered portion.”

Such a configuration leads to advantages over the prior art, such as “the small-diameter portion (e.g., 10a) and the large-diameter portion (e.g., 10b) can be smoothly linked (via the tapered portion, e.g., 10c, owing to the formation by the varied thickness of the sheathing resin)”, as described in the specification at page 5, lines 12-25.

In contrast, referring to Figs. 7 and 8 of Gregory, respective parts of the small-diameter portion, the large-diameter portion, and the tapered portion are joined together. This is very different from a formation by varying the thickness of the sheathing resin as recited in claims 1 and 17.

That is, in Gregory, as shown in Fig. 7, a first lumen 12A is fitted with a second lumen 12B, and a tapered surface 15 formed at the end of the second lumen 12B is deformed so as to form a tapered portion 13. Such a configuration of the tapered portion 13 of Gregory makes it difficult to have a smooth link (transition) in a manner that the tapered portion smoothly links the small-diameter portion and the large-diameter portion.

With regard to the rejection of claims 1-4 and 17 under 35 U.S.C. § 103(a), independent claims 1 and 17 are not rendered obvious by the cited references because neither the Gregory patent nor the Boury patent, whether taken alone or in combination, teach or suggest an endoscope or an insertion unit for an endoscope, respectively, having the features discussed above and recited in independent claims 1 and 17. Accordingly, claims 1 and 17 patentably distinguish over the prior art and are allowable. Claims 2-4 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-4 and 17 under 35 U.S.C. § 103(a).

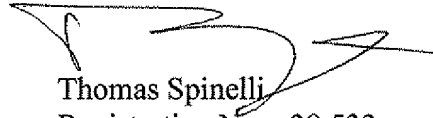
With regard to the rejection of claims 5-16 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 5-16 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 5-16 under 35 U.S.C. § 103(a).

Furthermore, new claim 18 has been added to further define the patentable invention. New claim 18 is fully supported in the original disclosure, such as at page 6, lines 16-22 of the specification and at Figure 3 of the drawings. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 18. Applicants respectfully submit that new claim 18 is at least allowable as depending upon an allowable base claim (1).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicants' attorneys would be advantageous to the disposition of this case,
the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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